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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,090	11/06/2006	Joachim Lohr	L7725.06112	1252
53989 7590 05/28/2008 DICKINSON WRIGHT PLLC 1901 L STREET NW SUITE 800 WASHINGTON, DC 20036			EXAMINER TORRES, JOSEPH D	
			ART UNIT 2112	PAPER NUMBER
			MAIL DATE 05/28/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/583,090

Applicant(s)

LOHR ET AL.

Examiner

Joseph D. Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-37 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) 51-53 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-37 and 40 is/are allowed.
- 6) ☒ Claim(s) 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date 03/07/2008.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 51-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/25/2007.

This application contains claims 51-53 drawn to an invention nonelected with traverse in the reply filed on 10/25/2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

Applicant's arguments filed 04/21/2008 have been fully considered but they are not persuasive.

The Applicant contends, "Applicants respectfully submit that the Final Rejection's basis for the applied objections and indefiniteness rejections is unsupported by law. As stated in MPEP 2173.01, an "[a]pplicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim **which makes clear the boundaries of the subject matter** for which protection is sought" (see MPEP 2173.01 lines 7-11). As noted by the court in *In re Swinehart*, 439 F.2d 210

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(CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought (see MPEP 2173.01 lines 11-15)." [Emphasis added]

The Examiner asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, the boundaries of the subject matter for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art.

Furthermore; in *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976), it is clearly pointed out that functional limitations are only excluded from considerations under 35 U.S.C. 112, second paragraph, when a functional limitation imparts some structural limitation on an apparatus (i.e. sleeves "adapted to be fitted" Note: a sleeve "adapted to be fitted" requires a specific physical alteration to a sleeve since any sleeve that is not "adapted to be fitted" is necessarily structurally different from what is being claimed). Since the functional matter recited in the Applicant's claims can be implemented in software or can be implemented without requiring structural changes to existing circuitry

that does not implement such a function such as programmable logic, the functional matter in the Applicant's claims does not conform to the requirement that a limitation for an apparatus distinguish from the Prior Art in terms of structure rather than function. The functional matter in the Applicant's claims instead raises questions as to the structural connection of the functional matter to structural elements in the claim to the degree that it is not even clear, if the functional matter as recited imparts any structural connection to any structural element in the claim. As such, the functional matter as recited in claims 41-50, is indefinite and fails to comply with 35 U.S.C. 112, second paragraph.

Claim Objections

Claims 42-50 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The Examiner asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

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Since the functional matter recited in the Applicant's claims can be implemented in software or can be implemented without requiring structural changes to existing circuitry that does not implement such a function such as programmable logic, the functional matter in the Applicant's claims does not conform to the requirement that a limitation for an apparatus distinguish from the Prior Art in terms of structure rather than function.

The functional matter in the Applicant's claims instead raises questions as to the structural connection of the functional matter to structural elements in the claim to the degree that it is not even clear, if the functional matter as recited imparts any structural connection to any structural element in the claim. As such, the functional matter as recited in claims 41-50, is indefinite and fails to comply with 35 U.S.C. 112, second paragraph.

Claim 42-46 and 50 fail to recite any structural element and/or structural cooperative relationships to the existing structural elements in the claim 41, i.e.,

"transmitter", "receiver" and "processing unit", for implementing the functional limitations in claims 42-46 and 50.

Claims 47-49 recite a functional elements "MAC-d entity" and "MAC-d entity" from a 3GPP modified version Open Systems Interconnection (OSI) Basic Reference Model. Claim 47-49 fail to recite any structural element and/or structural cooperative relationships to the existing structural elements in the claim 41, i.e., "transmitter", "receiver" and "processing unit", for implementing the functional limitations in claims 47-49.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 41-50 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

Claims 41-50 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

Claim 1 recites the following functions, "operable to transmit a data packet to the base station via the uplink data channel using a hybrid automatic repeat request (HARQ) retransmission protocol providing soft combining of data packets and synchronous

retransmissions", "operable to receive a HARQ feedback message from the base station, wherein the feedback message indicates that the data packet has not been successfully decoded by the base station", "operable to determine whether the transmission power required for synchronously transmitting a retransmission data packet~ for the unsuccessfully decoded data packet, at a predetermined point in time after having received the feedback message and for transmitting other uplink data within the same transmission time interval is lower than a maximum allowed transmission power the mobile station is allowed to utilize for transmitting uplink data, wherein the other uplink data is prioritized over the retransmission data packet" and "wherein the transmitter of the mobile terminal is operable to synchronously transmit the retransmission data packet at the predetermined point in time after having received the feedback message and to transmit the other uplink data to the base station using the maximum allowed transmission power, if the required transmission power is larger than the maximum allowed transmission power", but fails to recite any structural element and/or structural cooperative relationships to the existing structural elements in the claim, i.e., "transmitter", "receiver" and "processing unit", for implementing the functional limitations.

The Examiner asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

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Furthermore; in *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976), it is clearly pointed out that functional limitations are only excluded from considerations under 35 U.S.C. 112, second paragraph, when a functional limitation imparts some structural limitation on an apparatus (i.e. sleeves "adapted to be fitted" Note: a sleeve "adapted to be fitted" requires a specific physical alteration to a sleeve since any sleeve that is not "adapted to be fitted" is necessarily structurally different from what is being claimed). Since the functional matter recited in the Applicant's claims can be implemented in software or can be implemented without requiring structural changes to existing circuitry that does not implement such a function such as programmable logic, the functional matter in the Applicant's claims does not conform to the requirement that a limitation for an apparatus distinguish from the Prior Art in terms of structure rather than function. The functional matter in the Applicant's claims instead raises questions as to the structural connection of the functional matter to structural elements in the claim to the degree that it is not even clear, if the functional matter as recited imparts any structural connection to any structural element in the claim. As such, the functional matter as recited in claims 41-50, is indefinite and fails to comply with 35 U.S.C. 112, second paragraph.

Claim 42-46 and 50 fail to recite any structural element and/or structural cooperative relationships to the existing structural elements in the claim 41, i.e., “transmitter”, “receiver” and “processing unit”, for implementing the functional limitations in claims 42-46 and 50.

Claims 47-49 recite a functional elements “MAC-d entity” and “MAC-d entity” from a 3GPP modified version Open Systems Interconnection (OSI) Basic Reference Model. Claim 47-49 fail to recite any structural element and/or structural cooperative relationships to the existing structural elements in the claim 41, i.e., “transmitter”, “receiver” and “processing unit”, for implementing the functional limitations in claims 47-49.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf; Jack K. (US 5983383 A).

35 U.S.C. 102(b) rejection of claims 41-50.

Figure 5 in Wolf teaches a "transmitter" 116, "receiver" 104 for a mobile unit and claim 8 in Wolf teaches "processing unit" fully operable for implementing programmable functions.

Claim 1 recites the following functions, "operable to transmit a data packet to the base station via the uplink data channel using a hybrid automatic repeat request (HARQ) retransmission protocol providing soft combining of data packets and synchronous retransmissions", "operable to receive a HARQ feedback message from the base station, wherein the feedback message indicates that the data packet has not been successfully decoded by the base station", "operable to determine whether the transmission power required for synchronously transmitting a retransmission data packet~ for the unsuccessfully decoded data packet, at a predetermined point in time after having received the feedback message and for transmitting other uplink data within the same transmission time interval is lower than a maximum allowed transmission power the mobile station is allowed to utilize for transmitting uplink data, wherein the other uplink data is prioritized over the retransmission data packet" and "wherein the transmitter of the mobile terminal is operable to synchronously transmit the retransmission data packet at the predetermined point in time after having received the feedback message and to transmit the other uplink data to the base station using the maximum allowed transmission power, if the required transmission power is larger than the maximum allowed transmission power", but fails to recite any structural element and/or structural cooperative relationships to the existing structural elements in the

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claim, i.e., "transmitter", "receiver" and "processing unit", for implementing the functional limitations.

The Examiner asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, **the boundaries of the subject matter** for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art.

Allowable Subject Matter

Claims 28-37 and 40 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph D. Torres
Primary Examiner
Art Unit 2112

/Joseph D. Torres/
Primary Examiner, Art Unit 2112